

Application No.: 09/202,681

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Docket No.: 564462001001

REMARKS**Status of the Claims***Pending claims*

Claims 1 to 11, 13 to 21 and 31 to 52 are pending.

Claims added in the instant amendment

In the present response, claims 5 to 7, 13 to 17, 20, 21, 31 to 36 and 41 to 47 are canceled without prejudice or disclaimer, and new claims 53 and 54 are added. Accordingly, after entry of the instant amendment, claims 1 to 4, 8 to 11, 18, 19, 37 to 40 and 48 to 54, will be pending and under examination.

Applicants respectfully request entry of the amendments set forth in this response under 37 CFR §1.116. The amendment places the case in condition for allowance and places the case in better condition for appeal; the amendment does not raise any issues of new matter; and, the amended claims do not present new issues requiring further consideration or search.

Rejected claims were amended to be dependent on allowed claims or incorporate the limitations of allowed claims. Claims dependent on only allowed claims were not canceled.

Allowed claims

Applicants thank the Examiner for finding claims 1, 2 and 48 to 52 allowable.

Outstanding Objections and Rejections

The Patent Office maintained the rejection of claims 15 to 17, 20, 21 and 41 to 43 under 35 U.S.C. §112, first paragraph, written description requirement. The Patent Office maintained the rejection of claims 3 to 5, 10, 11, 13 to 21 and 31 to 44 under 35 U.S.C. §112, first paragraph, enablement requirement.

Applicants respectfully traverse all outstanding objections to the specification and claims and rejections of the claims.

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Support for the Claim Amendments

Support for the claim amendments can be found throughout the specification. Accordingly, Applicants respectfully submit that no new matter is introduced by the instant amendments.

Executed Rule 132 declaration

Applicants thank the Examiner for noting that a copy of an executed Rule 132 declaration as submitted in Applicants last response (May 18, 2004) is not in the PTO's file; and for considering the substantive comments in that declaration. A copy of the executed declaration is attached.

Issues under 35 U.S.C. §112, first paragraphWritten Description

The Patent Office maintained the rejection of claims 15 to 17, 20, 21 and 41 to 43 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors at the time the application was filed had possession of the claimed invention.

Applicants respectfully submit that the claimed invention is sufficiently described in the specification such that one of ordinary skill in the art would be able to ascertain the scope of the claims with reasonable clarity and recognize that Applicants' were in possession of the claimed invention at the time of filing for reasons set forth in Applicants previous responses, which are expressly incorporated herein. Applicants respectfully submit that describing a genus of polynucleotides in terms of physico-chemical properties (e.g., a % sequence identity or stringent hybridization to the exemplary SEQ ID NO:19 or nucleic acids encoding SEQ ID NO:28) and function (e.g., encoding a polypeptide having phosphatase activity) satisfies the written description requirement of section 112, first paragraph.

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However, merely to expedite prosecution and allowance of this application, rejected claims were amended to be dependent on allowed claims or incorporate the limitations of allowed claims, or canceled without prejudice or disclaimer (claims dependent on only allowed claims were not canceled).

In light of the above remarks, Applicants respectfully submit that the amended claims are sufficiently described in the specification to overcome the 35 U.S.C. §112, first paragraph, written description rejection.

Enablement

The Patent Office maintained the rejection of claims 3 to 5, 10, 11, 13 to 21 and 31 to 44 under 35 U.S.C. §112, first paragraph, as allegedly not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. The Patent Office states that the specification is enabling for polynucleotides which encode the amino acid sequence of SEQ ID NO:28 or enzymatically active fragments thereof.

Applicants respectfully aver that the specification enabled the skilled artisan at the time of the invention to identify, and make and use, the genus of phosphatase-encoding nucleic acids and phosphatases of the claimed invention for reasons set forth in Applicants previous responses, which are expressly incorporated herein.

However, merely to expedite prosecution and allowance of this application, rejected claims were amended to be dependent on allowed claims or incorporate the limitations of allowed claims, or canceled without prejudice or disclaimer (claims dependent on only allowed claims were not canceled).

Applicants respectfully submit that the pending claims meet the enablement requirement under 35 U.S.C. §112, first paragraph. In light of the above remarks, Applicants respectfully submit that the specification sufficiently described how to make and use the claimed methods to satisfy the requirements of 35 U.S.C. §112, first paragraph.

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CONCLUSION

In view of the foregoing amendment and remarks, it is believed that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. §112, first paragraph. Applicants believe all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

In the event the U.S. Patent and Trademark office determines that additional fees and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 564462001001. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please call the undersigned at 858 720 5133.

Dated: January 13, 2005

Respectfully submitted,

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